

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	ATTY'S DKT: CLASSEN=6A
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John Barthelow CLASSEN)	
)	
Appln. No.: 10/081,705)	
)	Washington, D.C.
Filed: February 21, 2002)	
)	October 25, 2010
For: COMPUTER ALGORITHMS AND)	
METHODS OF PRODUCT SAFETY)	

DECLARATION OF EVELYN H. MCCONATHY

I, Evelyn H. McConathy, declare as follows:

1. I have been a partner at Montgomery, McCracken, Walker & Rhoads, LLP, from November 16, 2006 until the present.
2. I was involved in the prosecution of the above-identified patent application.
3. On March 31, 2008, I prepared and filed an Appeal Brief in connection with the above-identified patent application. Exhibit A. As was my normal practice at the time, when paying the government fee for the Appeal Brief, I also paid the government fee of \$515 for an Oral Hearing, as I intended to file the request for oral hearing with a reply to the Examiner's Answer. See Exhibit A, pages 2 and 3.
4. As evidenced by the copy of the Appeal Brief downloaded from PAIR, I understood that the Oral Hearing fee had been processed and accepted by the U.S. Patent & Trademark Office (PTO). Exhibit A, page 3.
5. On August 1, 2008, I prepared and signed a Reply to the Examiner's Answer, a separate Request for Oral Hearing, a Declaration and a completed Transmittal Sheet. I gave those papers, including the Declaration by the inventor, two exhibits (including an unsigned

Letter of Invention, showing the original date of invention by the inventor), and a return postcard, to my secretary, Ashley Powell, asking her to file the papers. Exhibit B.

6. All individuals at this firm who were involved in any filing with the PTO were fully aware of the importance that filings be properly handled because dates are so important to our practice. As a result, at that time it was our standard practice that papers were hand carried to the mailroom and hand delivered to the Head of our Mailroom for delivery either by U.S. Postal Service Express Mail or U.S. Postal Service First Class Mail. Also as a further standard practice, after the filing had been posted by the mailroom, the secretary or paralegal responsible for the filing then confirmed to me that the package had been accepted for mailing by the Mailroom. It was, and is, my normal practice that the individual responsible for filing the papers at the US PTO confirms to me when each filing has been completed.

7. Normally, when return receipt postcards are received from the PTO, the Intellectual Property secretary or paralegal would add the return postcard to the corresponding file. Both in September of 2008 and recently, I reviewed the files for this case, and did not find a post card. It is, thus, my present understanding that we did not receive the return postcard in this case. Similarly, any Express Mail receipt with respect to an application filing is eventually placed in the file. When I reviewed the file, no Express Mail receipt was present with respect to the August 1, 2008, filing.

8. On September 27, 2008, I checked the PTO PAIR record for this case and discovered that the Reply Brief and the accompanying papers were not on the record. I notified my paralegal, James Gannon, in an email (Exhibit C) that the papers filed on August 1, 2008, in

this above-identified application were not showing up in PAIR. In this email I asked Mr. Gannon to investigate with the PTO why the papers were not showing up in PAIR.

9. This email indicates a concern I had when I first discovered the problem over the weekend, before physically checking the file that a paralegal then working for our office, Tara Fromm, may have been asked to file the papers. However, upon review of the record and the file, as well as the history of the document in our firm's FileSite document record, we determined that although the filing papers were assembled by Ms. Fromm for my signature, my secretary, Ms. Powell - not the paralegal - finalized the document, printed it for my signature, and actually completed the filing. Ms. Powell revised the Response after Ms. Fromm's final entry into FileSite. Ms. Powell then signed the attached Certificate of Mailing, and also the Postage Voucher for First Class Mail (Exhibit D). Although she used my name on the Postage Voucher, rather than her own, since I was the responsible attorney in the matter, I believe the handwriting to be Ms. Powell's, as opposed to Ms. Fromm's. Discovery of the missing PTO PAIR record of the filing was made after Ms. Fromm ceased to be employed by Montgomery McCracken. To the best of my knowledge, Ms. Powell had, in fact, deposited the papers with our Mailroom Department, physically handing the papers to the person in charge, after signing the certificate of mailing and they, in turn, deposited the filing in the U.S. first class mail on August 1, 2008. As was my normal practice, had I not received confirmation from her that the filing was complete, I would have made further inquiries before going home that night. Ms. Powell was a qualified and experienced IP secretary.

10. I have now confirmed that there is a billing record for \$1.85 for postage billed to our firm's docket number for this case on August 1, 2008, providing further corroboration that

the papers were mailed on that day by first class mail, but with a signed Certificate of Mailing under Section 1.8. The fee would have been substantially higher if the mail had been sent by Express Mail. Thus, this is evidence that the package was mailed on August 1, 2008, by first class mail.

11. I have no reason to believe that Ms. Powell did not follow the normal office procedures when filing the Reply Brief and accompanying papers. When we learned of the fact that the filing was missing from PAIR, Ashley Powell repeatedly assured me that she had filed the papers properly and that every procedure had been followed regarding hand-depositing the filing with our mailroom, and that the mailroom knew that it had to be mailed on that day.

12. Ashley Powell departed from this firm in the Spring of 2009. The last known phone number that I have for her was answered by a message stating the mailbox was full. I have talked with a number of people at my firm who remained friends with Ms. Powell for a while, but they have neither her current phone number, nor e-mail address. Their contact is through Facebook or through mutual friends. We have tried both ways of contacting her, leaving a message on Facebook and with the friends, but none have produced any response and we have been unable to locate Ms. Powell. We are currently checking to see if she remains in contact with the headhunter who introduced us to her at this firm, but that has not provided any result as of the date of the signing of this declaration.

13. As part of Mr. Gannon's standard practice, he would have provided rolling reports to me after having spoken with the USPTO. As such, he would have provided me with rolling reports on at least September 29th, September 30th, and October 1st, 2008, regarding the information provided to him by the USPTO on each respective day, regarding what alternatives

were available, and what evidence would be required by the PTO under 37 C.F.R. §1.8(c). Mr. Gannon told me that, as I suspected, Supervisory Examiner Mofiz said that a return postcard would be requested as additional evidence, and as a result, he was told to wait to see if the papers showed up in PAIR. He also explained that the individuals with whom he spoke at the US PTO had confirmed my plan to file a Request for Continued Examination (“RCE”) to enter both the completed Classen Declaration with the signed Letter of Original Invention, and to also restart the prosecution. This would have effectively caused the Appeal to be withdrawn, although a subsequent Appeal would have been permitted after the file was completed with the Classen Declaration.

14. I was, and continue to be, aware of all parts of Rule 1.8. However, it has been my experience in the past, when PTO filings have disappeared, that in each case I had received the postmarked return postcard in the case. As a result in those cases, I had the required additional evidence of delivery to the US PTO, as demanded under 1.8(c). In this case, because we had no postmarked return postcard, although we did have a copy of the postcard sent as part of the filing, and a copy of the signed Certificate of Mailing under 37 C.F. R. 1.8 on the August 1, 2008, Transmittal Sheet, experience dictated that we had insufficient evidence under 1.8(c), even if timely filed in compliance with 1.8(b). For this reason, I asked Mr. Gannon to contact the US PTO to determine alternatives to the additional evidence requirement under 1.8(c) when the postmarked return postcard had, in fact, not been returned. If it had been clear to me after seeking advice from the PTO that the postmarked return postcard would not be required, I would have promptly filed a Petition under 1.8. But Mr. Gannon was told that the postmarked return postcard would be required, and my own past experience told me that was true. The alternative

solutions were to wait for the papers and postcard to appear, or to file an RCE, or a combination thereof.

15. In light of the above, and given the PTO's verbal recommendation that we either wait, or file an RCE, it was my judgment at the time that filing a Petition without any postmarked return postcard in this matter seemed futile at the end of September 2008. As a result, I asked the client for permission to file an RCE to reopen the prosecution in this matter, so that the Declaration could be properly submitted and the Appeal could then be restarted, making the missing paper irrelevant. Exhibit E. Please also note that the Patent Examiner had lost this case for several years previously, so I was not surprised that these papers were also lost, and fully expected that they, too, would eventually turn up.

16. Since I had paid the government fee for an oral hearing, and had requested an oral hearing informally in the Appeal Brief, I believed that with the addition of the separately filed Request for Oral Hearing, that one would be scheduled. But the separate Request for Oral Hearing was lost with the Reply. Then, based on instructions from my client, I had planned on filing an RCE with amended claims, thereby withdrawing the appeal, but several times, and for a variety of reasons, the client asked me to wait before preparing the RCE. An Appeal sits in the queue for several years at the US PTO, and work on the RCE remained in flux with the client. The Appeal Board then made its decision without the requested Oral Hearing, even though payment had been acknowledged by the US PTO on PAIR.

17. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are

punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Dated: October 25, 2010

Evelyn H. McConathy
Evelyn H. McConathy